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JUL 06 2006 Attorney Docket No. GEMS8081.081

Patent

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Zhang et al.  
Serial No. : 09/681,483  
Filed : April 13, 2001  
For : Method and System to Request Remotely Enabled Access  
to Inactive Software Options Resident on a Device  
Group Art No. : 2135  
Examiner : Dada, B.

## CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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Date: July 6, 2006

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The request is being filed with a Notice of Appeal. The review is requested for the reasons set forth hereinafter.

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**REMARKS**

**JUL 06 2006**

Claims 1-6, 8-13, 15-17 and 19-31 are pending in the present application. The Examiner has rejected claims 17 and 19-23 under 35 U.S.C. §101. Additionally, claims 17, 19, 21-23 and 31 have been rejected under 35 U.S.C. §102(e) as being anticipated by Moeller et al (USP 6,694,384) and claims 20 and 24-29 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Moeller in view of Applicants Admitted Prior Art.

Applicant appreciates the allowability of claims 1-6, 8-13, 15, 16 and 30.

The Examiner has rejected claims 17 and 19-23 under 35 U.S.C. §101 as being directed to unpatentable subject matter. In the Response filed on June 5, 2006, Applicant amended claim 17 to call for a computer data signal process embodied in a carrier wave and representing a sequence of instructions originating from a computer program executed by a computer which, when executed by at least one processor, causes the at least one processor to display a GUI configured to facilitate a request over a first communication interface to enable an inactive option resident on a remote device, receive an input of a device identifier, receive a selection of a usage period, receive a selection of an inactive option for enablement from the GUI, cause a remote centralized processing station to generate a code configured to enable the selected inactive option after successful processing of the received inputs and selections, and transmit the code to the device having the inactive option over a second communication interface different from the first communication interface. Thus, Applicant contends that claim 17 calls for a statutory process that is directed to a practical application of a data signal.

In the Advisory Action of June 21, 2006, the Examiner rejected the amended claim, stating that "claim 17 is directed to a data signal, a data signal does not fall within one of the four statutory classes of 101." The Examiner's continued rejection ignores the substance of Applicant's amendment made in the prior Response. Claim 17 calls for a computer implemented process. Computer-implemented processes are statutory so long as they are limited to a practical application within the technological arts. *See MPEP § 2106; see also Diamond v. Diehr, 450 U.S. 175, 183-184 (1981)*. A claim is limited to a practical application when the process, as claimed, produces a concrete, tangible and useful result; i.e., the process recites a step or act of producing something that is concrete, tangible and useful. *MPEP § 2106; see AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358 (Fed. Cir. 1999)*. Applicant's independent

claim 17 recites the practical application of a computer data signal process embodied in a carrier wave that causes a processor to perform a series of process steps. The process acts carried out by the processor are a practical application of the computer data signal process, in that they cause the processor to: display a GUI, cause a remote processing station to generate a code, and transmit the code to a device having an inactive option. The process therefore produces a concrete, tangible and useful result, and thus results in a practical application. In light of the foregoing, Applicant believes that claim 17, and the claims dependent therefrom, are directed to statutory subject matter. As such, Applicant respectfully requests withdrawal of the Examiner's rejection under §101.

In the rejection of claims 17, 19, 21-23 and 31, the Examiner has repeatedly maintained a rejection that the claimed invention is anticipated by Moeller et al. In sustaining the §102(c) rejection, the Examiner maintains that "Moeller teaches displaying a GUI (i.e., selection from a menu) configured to facilitate a request over a first communication interface to enable an inactive option resident on a remote device... [column 4, lines 29-35 and lines 63-67] and transmitting the code to the device having the inactive option over a second communication interface different from the first communication interface [column 4, lines 41-46 and column 5, lines 1-10]." *Advisory Action, supra at 2.* The Examiner reached this conclusion notwithstanding that Moeller et al. fails to teach or suggest the use of a first communication interface to enable an inactive option resident on a remote device that is different from a second communication interface for transmitting the code to the device.

Moeller et al. clearly discloses that both the request and the key transmission for configuring an office device are made over the same communication interface. Moeller et al. discloses a system whereby a user accesses a list of available features through an interface on the office device to be reconfigured. The user then selects those features that he wishes to enable or download to the office device. Once the desired features are selected, this information is transferred to the office device company. Payment for the selected features is then secured over the Internet or via other secure means. The user then receives an access key or code via the internet to input into the scanner to activate the feature. The process described above is detailed in Moeller et al. at Col. 4, Ins. 29-35 and Ins. 41-46, and is shown in Fig. 2. The Examiner has improperly identified two separate communication interfaces in the described embodiment. Nowhere in the above description is the feature enablement request made over a first communication interface and access key or code transmission over a second communications

interface that is different from the first communications interface. Instead, both the request and the key transmission are made over the same interface, i.e., the internet.

Moeller et al. further discloses that the user can alternatively telephone the office device company to turn on the desired feature selected from a menu. In response to this telephonic request, the company gives the user an access code which will allow the scanner to configure itself. The access code is given to the customer by the company over the phone and the customer then inputs the access code into the scanner. *See Cols. 4-5, Ins. 63-67 and Ins. 1-10; see also Fig. 3.* Therefore, both the request and the access key are again transmitted in a common communications interface – namely, a telephone call.

Thus, contrary to the conclusions reached by the Examiner, Moeller et al. fails to teach or suggest the feature enablement request made over a first communication interface and the access key or code transmission over a second communications interface that is different from the first communications interface. In the system of Moeller et al., both the request and the key transmission are made over only one of either the internet, telephone, or other secure means. Claim 17 specifically calls for an enablement request to be made over a first communication and for transmission of a code over a second communication interface different from the first communication interface. Therefore, Moeller et al. cannot anticipate that which is called for in claim 17. As such, claim 17 and the claims that depend therefrom are patentably distinct over the art of record.

The Examiner has also repeatedly maintained the rejection to claims 20 and 24-29 under 35 U.S.C. §103(a) as being unpatentable over Moeller in view of Applicants Admitted Prior Art. The combination of Moeller and Applicants Admitted Prior Art, however, fails to teach or suggest that called for in claims 20 and 24-29. Claim 24 calls for, in part, a request to activate an inactive software program made over a public communication connection and an activation of an inactive software program over a private communication connection. As set forth above, in the several embodiments of the system disclosed by Moeller et al., a feature enablement request and the key transmission are made over the same connection – either internet or telephone. Moeller et al. fails to teach or suggest communicating a feature request over a public communication connection and communicating a software key over a private communication connection. Accordingly, that which is set forth in claim 24, and the claims dependent therefrom, is neither

disclosed nor suggested by Moeller et al. and thus, the Examiner's position is not supported by the disclosure of the cited reference.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-6, 8-13, 15-17 and 19-31.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned should the Examiner consider any matters unresolved.

Respectfully submitted,

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Attorney Docket No.: GEMS8081.081

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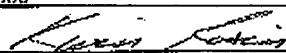
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**NOTICE OF APPEAL FROM THE EXAMINER TO  
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GEMS8081.081

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Typed or printed name Kevin R. Rosin

In re Application of  
Zhang et al.Application Number  
09/681,483 Filed  
April 13, 2001

For Method and System to Request Remotely Enabled Access to Inactive Software Options Resident on a Device

Art Unit  
2135 Examiner  
Beennet W. Dada

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))

\$ 500.00

- Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:
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- assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- attorney or agent of record.  
Registration number 38,388
- attorney or agent acting under 37 CFR 1.34.  
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Timothy J. Ziolkowski  
Typed or printed name(202) 376-5170  
Telephone numberJuly 6, 2006  
Date

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Submit multiple forms if more than one signature is required, see below\*.

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